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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/720,554	12/27/2000	Ayako Hohsaka	HOHSAKA-2	2522

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Browdy & Neimark
624 Ninth Street NW
Washington, DC 20001-5303

EXAMINER

ANGEBRANNDT, MARTIN J

ART UNIT	PAPER NUMBER
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1756

DATE MAILED: 04/01/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/720,554

Applicant(s)

HOHSAKA ET AL.

Examiner

Martin J Angebranndt

Art Unit

1756

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 17 March 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 6 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____


3. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: none.Claim(s) objected to: none.Claim(s) rejected: 1-6,8,9 and 12.

Claim(s) withdrawn from consideration: _____.

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☒ Other: See Continuation Sheet


Martin J. Angebranndt
Primary Examiner
Art Unit: 1756

Continuation of 3. Applicant's reply has overcome the following rejection(s): The rejections of claims 10 and 11 and the rejection of claims 1-9 over Sato et al. '839 alone. The rejection of Maeda et al. EP 0483387 is also withdrawn based upon the lack of a teaching of a halogen moiety on the methine chain linking the terminal moieties. The rejections of the claims relying in part upon Borrer, Mee et al., Lee et al., GB 355693 or Hamer et al. (paragraphs 7-9 in the final office action) are withdrawn as being cumulative.

Continuation of 5. does NOT place the application in condition for allowance because: The Applicant argues the references separately and the advantage of the increased solubility argued by the applicant on page 8 of the response cannot be used to assert unexpected results as this benefit is already appreciated in the art, specifically Sato et al. 839 at 4/20-30 and 2/10-15). As this benefit is appreciated in the art arguing it alone without a showing of an unexpected degree with the claimed species cannot obviate the rejections of record. The applicant fails to appreciate that an obvious rejection need not specifically exemplify the claimed compound. That would correspond to an anticipation rejection. Inagaki et al. specifically describes the use of halogens and alkyl moieties as substituents on the methine chain linking the terminal moieties in column 4 at line 32. The examiner stands by the position of the final office action, noting that the dyes in the table in columns 37-30 of Morishima et al., specifically B-3, B-10 and B-14, as well as that of col. 24 at lines 48-52, which teaches that the methine linkage may be substituted by the same as described for those of the nitrogen containing heterocyclic group, which includes halogens at col. 23/lines 15-16. The applicant argues that Sato et al. '839 merely makes the statement without providing data, making it suspect and rendering the meaning of high solubility unclear. The examiner notes that the data in the instant specification does not disprove the statement made in Sato et al. '839, but rather supports it. The issue of the degree of solubility raised by the applicant is one which the applicant is in a position to establish as testing is the purview of the applicant, not the PTO, which lacks testing facilities. It may be that the degree of solubility is something special, but the applicant has the burden of providing evidence of this. Proper declaration evidence of several pentamethine cyanine dyes inside and outside the scope of the claims establishing the degree of solubility accorded various cyanine dyes would be of interest. When viewing In re Lee, evidence is not limited to data, but would include statement in the record or specification. With clear motivation concerning solubility, the same motivation as argued by the applicant, the Graham V. Deere factors are met, without impermissible hindsight by pointing to the motivation to make the substitutions argued. Claim 12 is similar to claim 7 and the rejections of record as applying to claims 1-9 are applied to claims 1-6,8,9 and 12. The applicant apparently thinks that Sato et al. '839 is in the rejection of paragraph 6 of the final office action. It actually refers to Saito et al. '089, which discloses halogen atoms in the methine chain in column 5 at lines 45-48. The examiner is of the position that making the substitution of the halogen for the hydrogen or methyl moiety would have been obvious in view of the disclosure of equivalence in Inagaki et al. and Saito et al. '089. The applicant bears the responsibility of showing the criticality of the solubility with respect to the claimed dyes over those of the prior art.

Continuation of 10. Other: The applicant left the formula out in claim 1, but as this is an obvious error, the examiner corrected this omission (MPEP 1305, 1302.04(I) and original claims).

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3/31/03